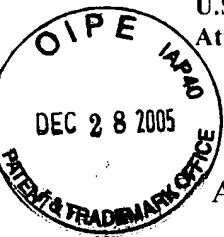


APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 09/754,378
Attorney Docket No. 031792-0311531

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF: Craig W. BARNETT *et al.*
SERIAL No.: 09/754,378
ATTORNEY DOCKET No: 031792-0311531
FILING DATE: January 5, 2001
ART UNIT : 3622
EXAMINER A. DURAN
FOR: METHOD AND SYSTEM FOR ELECTRONIC DISTRIBUTION OF PRODUCT
REDEMPTION COUPONS

ADDENDUM TO
APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

Further to Appellants' Brief on Appeal filed March 10, 2005, and a first Addendum filed August 8, 2005, Appellants submit this Addendum to provide a copy of a Decision on Appeal issued by the Board of Patent Appeals and Interferences on December 12, 2005, in a related application.

Although it is believed that no fees are due in connection with the filing of this Addendum, the Director is authorized to charge any fees that may be due to Deposit Account No. 033975 (Ref. No. 031792-0311531).

REMARKS

A Decision on Appeal ("Decision") was issued by the Board of Patent Appeals and Interferences on December 12, 2005, in related U.S. Patent Application Serial No. 09/537,793, filed March 29, 2000 (the "'793 Application").

The '793 Application was cited by Appellants in the March 10, 2005 Appeal Brief under the heading entitled: II. RELATED APPEALS AND INTERFERENCES - 37 C.F.R. §41.37(c)(1)(ii). See 03/10/05 Appeal Brief at pg. 3.

Accordingly, Appellants are submitting herewith a copy of the Decision as **Exhibit C** under the heading entitled: X. RELATED PROCEEDINGS INDEX - 37 C.F.R. §41.37(c)(1)(x). See 8/8/05 Addendum at pg. 2.

In the Decision, the Board of Patent Appeals and Interferences did not sustain the Examiner's rejections under 35 U.S.C. §102 based on U.S. Patent No. 5,227,874 to Von Kohorn. In addition, the Board did not sustain the Examiner's rejections under 35 U.S.C. §103 over Von Kohorn in view of U.S. Patent No. 5,734,823 to Saigh *et al.* ("Saigh").

In the instant application (currently under Appeal), the Examiner has also rejected claims under 35 U.S.C. §103 over Von Kohorn in view of Saigh. Therefore, the Decision in the '793 Application is being provided for the consideration of the Board. If any additional information is required, please do not hesitate to contact the undersigned at the number provided.

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

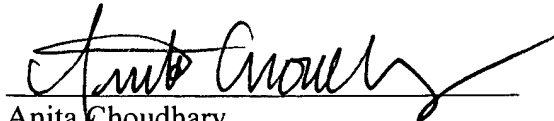
U.S. Application Serial No. 09/754,378

Attorney Docket No. 031792-0311531

Date: December 28, 2005

Respectfully submitted,

By:

A handwritten signature in black ink, appearing to read "Anita Choudhary", written over a horizontal line.

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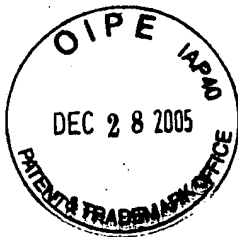
Main: 703-770-7900

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Fax: 703-905-2500



EXHIBIT C



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

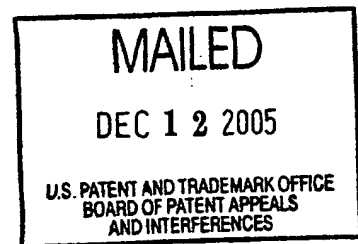
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG W. BARNETT,
KAREN R. REISNER and MARK BRAUNSTEIN

Appeal No. 2005-2251
Application No. 09/537,793

HEARD: NOVEMBER 15, 2005



Before JERRY SMITH, BARRETT, and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 47-54, which constitute all the claims pending in this application.

The disclosed invention pertains to an on-line coupon distribution system. More particularly, the invention downloads coupon information from a host computer to a client computer where a paper coupon is printed by the client computer. One aspect of the claimed invention is that the printed coupon contains identifying indicia identifying the client computer.

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Representative claim 47 is reproduced as follows:

47. A coupon distribution system comprising:
a client computer accessible by a potential consumer;
a printer connected to said client computer;
a host computer, said host computer containing coupon
information relating to available coupons being offered to the
potential consumer for redemption upon purchasing a product;
a communication device connected between said client
computer and said host computer whereby the coupon information
may be downloaded to said client computer upon the potential
consumer indicating an interest in the product, wherein said
printer prints out a paper coupon based on the coupon information
downloaded from said host computer; and identifying indicia
identifying said client computer printed on the paper coupon.

The examiner relies on the following references:

Von Kohorn	5,227,874	July 13, 1993
Saigh et al. (Saigh)	5,734,823	Mar. 31, 1998

Claims 47, 48 and 50-53 stand rejected under 35 U.S.C.

§ 112, first paragraph, as containing subject matter that was not
described in the specification in such a way as to reasonably
convey to one skilled in the relevant art that the inventors, at
the time the application was filed, had possession of the claimed
invention. Claims 47-53 also stand rejected under 35 U.S.C.

§ 102(b) as being anticipated by the disclosure of Von Kohorn.

Claim 54 stands rejected under 35 U.S.C. § 103(a). As evidence
of obviousness the examiner offers Von Kohorn in view of Saigh.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of lack of written description, anticipation and obviousness relied upon by the examiner as support for the prior art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that appellants' specification fails to support the invention now being claimed. We are also of the view that the evidence relied upon by the examiner fails to support the examiner's prior art rejections. Accordingly, we affirm.

We consider first the examiner's rejection of the claims under the first paragraph of 35 U.S.C. § 112. With respect to claims 47, 50, 52 and 53, the examiner objects to the phrase "identifying indicia identifying said client computer printed on

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the paper coupon" because the specification only supports the identification of the client or the on-line address of the client, and not the computer itself. With respect to claims 48 and 51, the examiner objects to the phrase "wherein: the identifying indicia is encrypted" because the specification does not support this recitation [answer, pages 3-4].

With respect to claims 47, 50, 52 and 53, appellants argue that the claim language is fully supported by the disclosure. Appellants point to several forms of identification associated with the user and argue that, therefore, the personal computer associated with the user is identified [brief, pages 10-11]. The examiner responds that appellants' specification only provides support for identifying the user and not for the specific computer used by the user. The examiner notes that a user's email or social security number identifies the user but not the specific computer [answer, pages 9-10]. Appellants respond that the specification teaches a user ID barcode transmitted to the user's computer, and that such barcode can be an online identification number which identifies the user's computer [reply brief, pages 2-3].

We will sustain the examiner's rejection of claims 47, 50, 52 and 53 for the reasons argued by the examiner. We agree with

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the examiner that each of the forms of identification discussed in appellants' specification identifies the user only and does not identify the user's computer. The user ID barcode, as disclosed, contains information which describes the user, not the user's computer. An online identification, such as an email address, also identifies the user and not the computer. A user can change computers and still receive email at the same address because the email address describes the user and not the computer. Thus, appellants' specification does not provide support for the recitation that the client computer is identified. Although most computer users may only use a single computer so that the identification of the user is tantamount to identifying the user's computer, the fact of the matter is that the types of identification described in appellants' specification only identify the user of the computer and do not uniquely identify the user's computer itself.

With respect to claims 48 and 51, appellants argue that the specification describes unique user identification data is encoded into a user-specific barcode. Appellants assert that the translation of unique identification data into a barcode is a form of encryption [brief, page 11]. The examiner responds that

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the encryption disclosed by appellants involves the electronic transmittal of information and not the information printed on the coupon. The examiner asserts that a barcode is not encrypted because it can be read by any barcode reader and is not secure. The examiner also notes that appellants have distinguished between encryption and encoding in their specification [answer, pages 10-11]. Appellants respond that a barcode is a form of visual encryption and requires a special reader to decrypt the data [reply brief, page 3].

We will sustain the examiner's rejection of claims 48 and 51. We again agree with the examiner that appellant's own specification indicates a recognized difference between information that is encoded and information that is encrypted. The specification describes encrypting user identifying information that is transmitted to an Internet site. Encryption generally implies that the information is hidden within a cipher that can only be decrypted by specific parties who have the cipher key. The barcode of appellants' disclosed invention simply encodes the user information into a form that can be printed on the coupon and read by any barcode reader. There is no suggestion in appellants' specification that the identifying

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information printed on the coupon is encrypted as a form of security. Therefore, appellants' specification does not support the invention of claims 48 and 51.

The examiner's rejection of the claims under the first paragraph of 35 U.S.C. § 112 fails to address claims 49 and 54. Since claim 49 depends from claim 47, and since claim 47 is not supported by the specification for reasons discussed above, then dependent claim 49 is also not supported by the specification of this application. The failure of the examiner to reject claim 54 is a clear oversight on the part of the examiner. The last clause of claim 54 has the exact language that the examiner objected to with respect to claims 47, 50, 52 and 53. Since the failure to reject claim 54 is a clear oversight on the part of the examiner, and since claim 54 has the exact same objectionable language as claim 47, we find that claim 54 is not supported by appellants' specification for the same reasons discussed above with respect to claim 47.

We now consider the rejection of claims 47-53 under 35 U.S.C. § 102(b) as being anticipated by Von Kohorn. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every

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element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how the claimed invention is believed to be fully met by the disclosure of Von Kohorn [answer, pages 4-6]. With respect to independent claims 47 and 53, appellants argue that Von Kohorn is not a coupon distribution system and does not disclose a client computer. Appellants also argue that Von Kohorn fails to disclose downloading coupon information from a host computer to a client computer upon a potential consumer taking an interest in the product [brief, pages 14-15]. The examiner responds that Von Kohorn discloses a coupon distribution system, a client or personal computer, and a communication device, and the examiner cites several portions of Von Kohorn to support this position [answer, pages 12-17]. Appellants respond that none of the portions of Von Kohorn cited by the examiner show downloading coupon information upon the

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consumer indicating an interest in the product. Appellants note that the consumer in Von Kohorn receives a listing of all coupons and discounts and coupon information is not downloaded upon the consumer indicating an interest as claimed. Appellants also argue that in Kohorn the individual household members are identified and not the client computer as claimed. Thus, appellants assert that the identity of the response units is not printed on the coupons in Von Kohorn [reply brief, pages 3-6].

We will not sustain the examiner's rejection of independent claims 47 and 53 for essentially the reasons argued by appellants in the briefs. Most importantly, we agree with appellants that the downloading of coupon information in Von Kohorn is not based upon the potential consumer indicating an interest in the product. Coupon information in Von Kohorn is downloaded regardless of whether the consumer has an interest in the product. Since the rejection is based on anticipation, Von Kohorn fails to disclose every feature of the claimed invention.

With respect to independent claim 50, appellants argue that Von Kohorn is not an on-line coupon distribution system and that Von Kohorn does not disclose a secured coupon data storage area within the host computer. Appellants also argue that Von Kohorn

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fails to disclose enabling a consumer to request and download coupons from a host computer [brief, pages 16-17]. The examiner disagrees with appellants' positions and cites several portions of Von Kohorn to support the examiner's position [answer, pages 17-22].

We will not sustain the examiner's rejection of independent claim 50 for essentially the reasons argued by appellants in the briefs. We agree with appellants that the examiner has failed to support his findings that Von Kohorn discloses each and every element of the claimed invention.

With respect to independent claim 52, appellants make the same arguments that we have considered above. Therefore, we will not sustain the examiner's rejection of claim 52. With respect to dependent claims 48, 49 and 51, appellants rely on the same arguments discussed above with respect to the independent claims. Therefore, we will not sustain the examiner's rejection of these claims.

We now consider the rejection of claim 54 under 35 U.S.C. § 103 based on Von Kohorn and Saigh. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness.

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See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroval, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of

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the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner essentially finds that Von Kohorn teaches the invention of claim 54 except that Von Kohorn does not disclose use of the Internet as a communication channel or downloading from an Internet accessible location. The examiner cites Saigh as teaching use of the Internet for downloading promotional material. The examiner finds that it would have been obvious to the artisan to add Saigh's teaching of the Internet to Von Kohorn [answer, pages 6-8].

Appellants argue that the rejection is improper because the references are non-analogous to the claimed invention. Appellants assert that the references are outside appellants' field of endeavor and that they are not reasonably pertinent to the particular problems with which appellants were involved.

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Appellants also argue that there is no teaching, suggestion or motivation to modify Von Kohorn to include the teachings of Saigh [brief, pages 18-24].

The examiner responds that Von Kohorn and Saigh are analogous art because they both provide information and content to the user that can include promotions, advertising and coupons. The examiner also notes that Saigh was cited only to show the advantages of using the Internet [answer, pages 23-26].

Appellants respond that it is not enough that the two applied references have something in common. Appellants reiterate that Von Kohorn and Saigh do not relate to the electronic distribution of coupons or relate to the problems addressed by appellants. Appellants also reiterate their position that there is no motivation to combine the references [reply brief, pages 6-11].

We will not sustain the examiner's rejection of claim 54. Since the rejection of claim 54 requires the teachings of Von Kohorn, and since the examiner's findings with respect to Von Kohorn are incorrect for reasons discussed above, we find that the evidence of record does not support the examiner's rejection.

In summary, the rejection of claims 47-54 has been sustained with respect to the rejection under 35 U.S.C. § 112, but the

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prior art rejections of these claims have not been sustained.
Therefore, the decision of the examiner rejecting claims 47-54
is affirmed.

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Application No. 09/537,793

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